

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 8/9/2011 have been entered. Claims 4, 5, 13 and 14 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. Claims 4, 5, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, in claim 4, line 12, the term "specific-wavelength-light" is vague and indefinite. It is unclear what the scope of the "specific-wavelength-light" is.

Clarification or proper amendment is required. Absent a proper response in the next reply, it will be deemed as non-responsive.

### ***Rejections Based on Prior Art***

5. Claims 4, 5, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa et al. (US 6090473) in view of Ozawa (US 6638624).

Yoshikawa's invention relates to an electromagnetic wave shielding and light transmitting plate for a front filter of a plasma display panel. See col. 1, ll. 8-10. Fig. 6a illustrates an embodiment of the filter comprising successively an antireflective layer 65, a transparent substrate 62A, and an adhesive layer 64. See col. 17, ll. 15-22. The adhesive layer may include small amounts of ultraviolet absorbing agent, infrared absorbing agent, and coloring agent, etc. See col. 11, ll. 19-22.

For claims 4 and 5, since Yoshikawa's filter is inherently transparent for viewing the plasma display, the base resins used are necessarily transparent. Yoshikawa lacks a teaching of forming a discrete transparent resin layer which consists of a near infrared absorbing agent, and an adhesive layer consists of a coloring agent for color tone correction or color tone adjustment. However, Ozawa's invention relates to a plasma display panel filter comprising a coloring matter (coloring agent) for controlling the tone (color tone adjustment) or increasing the purity of luminescence color (color tone correction of emission spectrum). See Abstract and col. 1, ll. 10-14. Various known coloring matter includes anthraquinone, azo, etc. See col. 13, ll. 63-67. The filter can have additional layers, such as a near-infrared (near-IR) absorbing layer, an antireflection layer, and the like. These layers may be provided in an arbitrary order. See col. 15, ll. 27-32. The near-IR absorbing layer can be provided as an independent resin layer containing a near-IR absorber. See col. 15, ll. 38-40. It would have been an obvious modification to one of ordinary skill in the art to substitute Yosikawa's filter with a functionally equivalent embodiment having additional independent layer consisting of a near infrared absorbing agent in a transparent resin sandwiched between the transparent substrate and an adhesive layer, and modifies the adhesive layer to be consisting of a coloring agent for color tone

correction, as taught by Ozawa. The selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. As to the coloring agent for color tone adjustment, since it is optional, it does not constitute a limitation in any patentable sense, and there is no requirement for the prior art to provide or account for the limitation. Furthermore, even if the optional coloring agent for color tone adjustment is considered, since Ozawa teaches various color matter can be used for color tone correction or color tone adjustment, as set forth above, the collective teachings render all the structure and composition of the claimed invention obvious, selecting workable different color matter, such as anthraquinone and azo, etc., for different color tone correction or color tone adjustment in separate layers is deemed to be obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain required optical properties for the same end uses (front filters for plasma display panels).

For new claims 13 and 14, since the optional coloring agent for color tone adjustment is not to be considered, the term "different" is meaningless. Further, even if it is considered, Ozawa teaches various coloring agents as set forth above.

### ***Response to Arguments***

6. Applicants argue at page 3:

reading the claim in light of the specification, one of ordinary skill in the art would not find "specific-wavelength-light" to be indefinite because they would understand the "specific wavelengths" are the wavelengths absorbed by the coloring agents. Moreover, claim 4 specifies the specific compounds that can be selected for the coloring agent for color tone correction and coloring agent for color tone adjustment. The "specific wavelengths" absorbed by these compounds are known in the art and described, in part, in the specification.

However, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, nowhere in claim 4, the term “specific-wavelength-light” is limited to any of the three recited wavelength ranges (560-620 nm, 380-440 nm, 640-780 nm). As such, the examiner maintains that the scope of “specific-wavelength-light” is vague and indefinite.

Applicants argue at pages 6-7:

Ozawa does not teach, suggest or establish a reason or rational for one skilled in the art to provide the single layer of Yoshikawa in separate layers as claimed. Ozawa teaches different layers for different purposes and provides no reason or rationale for one of ordinary skill in the art to have increased the number of layers in Yoshikawa to arrive at the claimed invention with any reasonable expectation of success.

However, Ozawa clearly teaches that the filter can have additional layers, such as a near-infrared (near-IR) absorbing layer, an antireflection layer, and the like, and these layers may be provided in an arbitrary order. In other words, Ozawa teaches functionally equivalent embodiments.

There is no requirement for Ozawa to provide any additional reasoning for selection of any functionally embodiment for end use. Further, it would have been *prima facie* obvious to one of ordinary skill to substitute Yoshikawa’s filter with a functionally equivalent alternative embodiment taught by Ozawa. When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield predictable results to be patentable under 35 U.S.C. § 103(a). *KSR*, 127 S. Ct. at 1740.

Applicants' argument at pages 7-8 directed to "color tone adjustment" is immaterial to the patentability of the claimed invention, because the limitation "color tone adjustment" is being recited as "optional" in claim 4.

Pointing to process aspects required for the different embodiments between single layer and multilayer filters pages 9-10, applicants argue at page 10:

taken separately or collectively, the applied references fail to teach or suggest the unexpected results of the claimed invention.

However, inherent differences in processes for making structurally different embodiments are not "unexpected results" in product properties.

Finally, applicants' continued arguments at pages 10-11 directed to Yoshikawa individually fails to recognize the grounds of rejection is not 102 based, and the 103 rejection based on the collective teachings of prior art render all the structural and compositional features of the claimed invention obvious. Applicants' arguments are misplaced and unpersuasive.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia Chevalier can be reached on 571-272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1788